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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,228	11/17/2003	Teresa Hickok	19783-025001 / 24/1197US	5020
20985	7590	10/23/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/715,228	HICKOK ET AL.	
	Examiner	Art Unit	
	John J. Wilson	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure does not adequately describe or show "at least one straight, central axis" and does not describe a "intermediate portion has a thickness that is greater on a first side of said axis than on a second side of said axis".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, "the proximal end, intermediate portion, and distal end extending along at least one straight central axis", lines 3 and 4, and "at least one bend in said intermediate portion" are unclear because they are contradictory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173). Banko shows an ultrasonic tip, shank 14, Fig. 1A, connector 14a enclosing a hollow internal volume 23, working end 22, void as shown in Fig. 1A, a hole at end of 21 that connects to a groove as shown, Fig. 1A and column 6, lines 10-14, and at least one bend, the bend from left to right in Fig. 1A is distal to the hole and groove interface. Banko shows a section of the tip towards the distal end that is relatively straight. To include a straight section is an obvious matter of choice in the specific shape of the shown tip as it is directed to a non-critical feature. As to claim 4, see column 7, lines 60 to column 8, line 3. To include a central axis that does not pass through the void is merely a matter of a choice in the degree of the depth of the void to one of ordinary skill in the art. As to claims 8 and 9, the specific shape of the groove is an obvious matter of choice in the shape of a known element to the skilled artisan. As to claim 10, the method of producing the groove is an obvious matter of choice in processing steps to one of ordinary skill in the art.

Claims 2, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Bussiere (D261932). Banko does not show a void having a planar base. Bussiere shows a void having a planar base. It would be obvious to one of ordinary skill in the art to modify Banko to include a void shaped as shown by Bussiere in order to make use of art known shapes of known structures.

Claims 11, 13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Jacoby (5230621). Banko shows the structure as described above, however, does not show using a rasp or file. Jacoby teaches using a file for the working end, column 2, line 47. It would be obvious to one of ordinary skill in the art to modify Banko to include a file as shown by Jacoby in order to make use of the desired tool to complete the desired procedure. The specific type of file used is an obvious matter of choice in known files to the skilled artisan. As to claim 15, Jacoby teaches a file, using cross grooves on a file is well known and would have been obvious to one of ordinary skill in the art. As to claim 16, Banko does not show using a hollow tube. Jacoby shows an embodiment in Fig. 3b that teaches a tube 53, 55 having an opening 57. The tube passes through the tip as show. Jacoby also shows an embodiment, Figs. 7, 7b, where the element 24 is located in a groove, Fig. 7b. It would be obvious to one of ordinary skill in the art to modify Banko to include a tube as shown by Jacoby in order to deliver the desired accessory to the work site. As to claim 17, to use a bushing is an obvious matter of choice in known ways of mounting a tube to the skilled artisan. As to claim 18, the specific range of length that the tube extends is

an obvious matter of choice in size and positioning of the known elements to one of ordinary skill in the art. As to claims 19 and 20, the shape of the shank is an obvious matter of choice in the shape of the tool to perform the desired procedure to the skilled artisan.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Hahn (6139320). Banko does not show a ball at the working end. Hahn shows using a ball working end 154, Fig. 13. It would be obvious to one of ordinary skill in the art to modify Banko to include a ball working end as shown by Hahn in order to use the tool needed to perform the desired procedure.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Kleesattel et al (3058218). Banko does not show a drill at the working end. Kleesattel shows using a drill, Fig. 7, at the working end. It would be obvious to one of ordinary skill in the art to modify Banko to include a drill working end as shown by Kleesattel in order to use the tool needed to perform the desired procedure.

Specification

The specification and/or drawings are objected to because element 303, axis or central axis, as described in the specification is not shown in the drawing. The only 303 in the drawings is shown in Fig. 11A, and it does not appear to be directed to an axis.

Response to Arguments

Applicant's arguments filed September 6, 2006 have been fully considered but they are not persuasive. In view of the unclear claim language and disclosure, Banko is held to obviously show the actual claimed structure as described above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
October 16, 2006